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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/647,777	12/29/2000	Hiroyuki Morimoto	2500.6	3913

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EXAMINER

TRAN, SUSAN T

ART UNIT PAPER NUMBER

1615

DATE MAILED: 12/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/647,777	<b>Applicant(s)</b> MORIMOTO ET AL.	
	<b>Examiner</b> Susan T. Tran	<b>Art Unit</b> 1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 October 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 29-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 29-41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \*    c) ☐ None of:  
         1. ☐ Certified copies of the priority documents have been received.  
         2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
         3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
     a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- |                                                                                                         |                                                                             |
|---------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                    | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

Receipt is acknowledged of applicant's Request for Continued Examination and Request for Suspension of Action filed 08/12/02, Amendment and Information Disclosure Statement filed 10/23/02.

#### ***Claim Objections***

Claim 31 is objected to because of the typographical error.

The word "water-unsoluble" should read "water-insoluble". Appropriate correction is suggested.

#### ***Specification***

The incorporation of essential material in the specification by reference to a foreign application or patent, or to a publication is improper. Applicant is required to amend the disclosure to include the material incorporated by reference. The amendment must be accompanied by an affidavit or declaration executed by the applicant, or a practitioner representing the applicant, stating that the amendatory material consists of the same material incorporated by reference in the referencing application. See *In re Hawkins*, 486 F.2d 569, 179 USPQ 157 (CCPA 1973); *In re Hawkins*, 486 F.2d 579, 179 USPQ 163 (CCPA 1973); and *In re Hawkins*, 486 F.2d 577, 179 USPQ 167 (CCPA 1973). Applicant's attention is called to the citation of the Japanese applications/patents JP-A-71-24231, JP-A-62-103012, JP-A-57-150612, and JP-A2-106 throughout the specification.

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***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 29-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morimoto et al. EP 0 650 826 A1, in view of Roche US 5,075,114.

Morimoto teaches a tablet compressing method using tableting machine with lubricant spraying mean (see abstract). The method comprising spraying lubricant uniformly on the surface of an upper punch, a lower punch, and a die, filling the die with pharmaceutical materials, and compressing the pharmaceutical material to form a drug tablet (columns 2-3 and columns 5-7).

Morimoto does not teach the specific form of pharmaceutical material being claimed, such as, coated granule in a matrix base. Nonetheless, Morimoto teaches that his tableting method can be used for tableting many kinds of tablets such as powdered or granular medicine, and so on (column 7, lines 34-38).

Roche teaches a medicament tablet comprising granules coated with polymers blend (see abstract and column 2, lines 45-60). The resulting coated granules were then compressed into tablet form using tableting machine having die wall and punches (columns 9-10). Thus, it would have been obvious for one of ordinary skill in the art to modify the pharmaceutical materials to be tabletted in Morimoto using the coated drug

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granule in view of the teaching of Roche, because the references teach the use of compressed tableting machine to compress pharmaceutical materials.

Claims 29-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsushima et al. US 6,036,974, in view of Roche US 5,075,114.

Tsushima teaches a method for preparation of tablet comprises preparing the tableting material containing medicines and excipients, coating on the surface of the tableting material a lubricant, coating the surface of the punches with lubricant, filling the die with the coated tableting material, and compressing to obtain tablet (columns 2 and 6).

Tsushima does not teach the specific form of pharmaceutical material being claimed, such as, coated granule in a matrix base.

Roche teaches a medicament tablet comprising granules coated with polymers blend (see abstract and column 2, lines 45-60). The resulting coated granules were then compressed into tablet form using tableting machine having die wall and punches (columns 9-10). Thus, it would have been obvious for one of ordinary skill in the art to modify the tableting materials of Tsushima using the coated drug granule in view of the teaching of Roche, because the references teach the use of compressed tableting machine to compress pharmaceutical materials.

The examiner notes that the reference is silent as to the teaching of the percent amount of lubricant being coated onto the surface of the die and punches as claimed in claim 34. However, it is the position of the examiner that such minute amount

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(0.0001%) would have been obvious for one of ordinary skill in the art to, by routine experimentation determine a suitable amount of lubricant to obtain a smooth surface tablet. As well as the dividing line on the tablet, it would have been obvious for one of ordinary skill in the art, because dividing line, groove line, marking line, or scored tablet is well known in pharmaceutical art.

### ***Correspondence***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan T. Tran whose telephone number is (703) 306-5816. The examiner can normally be reached on Monday through Thursday from 6:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page, can be reached at (703) 308-2927. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

  
**THURMAN K. PAGE**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 1600**